

### REMARKS

In response to the comments provided by the Examiner in the Advisory Action mailed April 9, 2008, Applicants submit the following remarks:

With regard to U.S. Patent No. 4,919,754 to Mollett et al. (“Mollett”), Applicants respectfully submit that the technology described in Mollett is quite different from that of the present application. In Mollett, the main principle is the polymerization of the hydrophobic precursors, where a dispersant (a dispersing power) is described as needed for obtaining a stable dispersion. There is no indication in Mollett about an inherent deinking power of the dispersant itself. When describing the dispersant, Mollett states, “We do not exclude the possibility of dispersing the resin precursor without a dispersant, or using the dispersing action of normal components of the pulp adventitiously present in the pulper.” See Mollett, col. 3, lines 49-52. So the dispersant cannot itself be important for the ink removal. Thus, as previously argued by Applicants, Mollett does not teach a deinking power of the dispersant. It is not even needed if there are other surfactants to disperse the resin precursor.

With regard to U.S. Patent No. 5,248,388 to Richmann et al. (“Richmann”), Applicants respectfully submit that this reference is limited to deinking of electrostatic printed paper, which according to the prior art, is said to have shown minimal success where it required surfactants with an HLB above 10. The invention describes surfactants with an HLB 0.5 – 10, preferentially 0.5 – 5 and a pH 5 – 12, temp. 110 – 190 °F and an aliphatic petroleum distillate (C<sub>9</sub>-C<sub>12</sub>). Richmann allows for ink aggregation at a neutral pH, in particular, allowing for ink separation by centrifugal cleaners or screening. Froth flotation as a separation method is only discussed in relation to the prior art technology, i.e. the one with limited effect on removal of electrostatic inks.

With regard to Point 3 of the Advisory Action, the Examiner suggests that dependent claims 7 to 11, 14 and 17 to 27 present additional combinations and limitations due to the amendment of Claim 1 that were not previously presented. The Examiner then states that these new combinations require further searching and consideration. However, the only amendments to Claim 1 were introduced by bringing in limitations which were originally present in the claims set (i.e. a combination of claims 1, 2, 12 and 16, which were originally submitted on December 15, 2006). Because the claim is therefore narrower based on limitations originally introduced in

dependent claims, no new subject matter is included in the claim scope that the Examiner did not previously have an opportunity to search. Hence, Applicants respectfully submit that no additional search is necessary, and that the previously submitted amendments should have been entered.

With regard to Point 11 of the Advisory Action, the Examiner suggests that the disclosed products in the cited art are identical or substantially identical, in structure or composition to those of the claimed invention, supporting a prima facie case of either anticipation or obviousness. However, such a general statement by the Examiner is not backed up with any evidence. Indeed, the vagueness of the description in Mollett must suggest that any 'generic' polyethyleneoxy-/polypropyleneoxy-functional polydimethylsiloxane should do the job. In this regard, Applicants direct the Examiner's attention to the additional experiments submitted in the previous response. Through the additional experiments, it can be seen that such a general approach, such as that offered in Mollett, has been disproved. The benefits of a selection, which is not taught or not deductible from any of the cited prior art teachings, renders Applicants' claimed invention patentable. It is shown through the comparative examples that no obvious selection can be made, not even in the value of HLB (which is not identified in the main definition of suitable organo-modified siloxanes in Mollett).

The Examiner suggests that Richmann teaches that additional methods of separation are usable including flotation. Applicants respectfully disagree. In contrast, Richmann suggests that flotation, which is described as the traditional process, has had minimal success. See col. 1, lines 19-27. Hence Richmann provides a very strong incentive for one of skill in the art to look for alternatives. One such alternative involves removing the toner particles through centrifugal cleaning and/or screening. See col. 1, lines 49-64. The context of this statement clearly suggests that this statement is linked to the invention disclosed in Richmann.

Lastly, the Examiner suggests that, of the additional examples, Siloxane G is outside of the scope of the invention, as the values of x and y are not integers. Applicants respectfully submit that the values of x and y provided are average values for the polymer and not absolute values for each of the units within the polymer. The values of q and s as defined in the claim relate to the values of a unit and not average values.

Applicants respectfully request reconsideration of this application in view of the amendments and remarks submitted on March 20, 2008, and the remarks submitted in this response. In particular, Applicants respectfully request that the examiner withdraw the rejections under 35 U.S.C. §§ 102(b) and 103(a) based on Mollett and Richmann.

**Except** for issue fees payable under 37 C.F.R. §1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 19-2380. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. §1.136(a)(3).

Respectfully submitted,

**NIXON PEABODY LLP**

/Jeffrey N. Townes, Reg. No. 47,142/  
Jeffrey N. Townes  
Reg. No. 47,142

Dated: May 20, 2008

**Customer No. 22204**  
NIXON PEABODY LLP  
401 9<sup>th</sup> St., N.W.  
Suite 900  
Washington, D.C. 20004  
202.585.8000